

This Opinion is Not
Citable as Precedent of
the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fowler Engineering Co., Inc.

Serial No. 75/793,268

John S. Egbert of Harrison & Egbert for Fowler Engineering Co., Inc.

Henry S. Zak, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Cissel, Bottorff and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Fowler Engineering Co., Inc., by the above-identified application, applied to register the phrase AUGERROD GROUNDING SYSTEM for goods identified as "multi-helix grounding electrodes, conductors, busses sold as a unit to bleed electrical charges to the earth" in International Class 9. While the application is based on applicant's assertion of its intention to use the phrase in commerce and has not been amended to assert actual use in commerce,

it appears that applicant is, in fact, using the phrase to promote its goods.

The examining attorney who issued the initial Office action refused registration of AUGERROD GROUNDING SYSTEM (set forth in typed form in the application drawing) under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1), on the ground that the phrase applicant seeks to register is merely descriptive of the product identified in the application.¹ The examining attorney included excerpts of articles from the NEXIS database that show generic or descriptive use of "auger rod," required applicant to submit a disclaimer of GROUNDING SYSTEM, and required the applicant to submit information or material about its product.

¹ The initial Office action reveals an improper approach to examination of the registrability of the phrase that is the subject of applicant's application, insofar as the examining attorney refused registration of AUGERROD as descriptive, in view of evidence attached to the action, and required a disclaimer of GROUNDING SYSTEM as descriptive without any explanation of the basis for the presumption of its descriptiveness. The proper approach is to assess the registrability of the phrase as a whole and to provide support for the refusal as to the whole phrase.

It would, of course, have been proper for the examining attorney to refuse the whole phrase and to state, as an alternative, that should the applicant overcome the refusal by argument or combined amendment to allege use and a showing of acquired distinctiveness, it would still have to disclaim any generic portion of the mark. While that may have been the intent behind the examining attorney's initial Office action, this was not so stated. Nonetheless, it is clear that applicant and the Office's examining attorneys (a different examining attorney took over review of the application after issuance of the initial

Applicant, in its response to the initial Office action, submitted the required disclaimer without comment and also submitted a copy of a patent for its product and an advertising flyer, which includes a schematic drawing-like depiction of the product. Applicant also included arguments why AUGERROD would not be viewed by its prospective customers as descriptive and why, therefore, the phrase should be registered with the disclaimer.

When the refusal was made final, applicant appealed and filed a request for reconsideration, resulting in a stay of the appeal. The examining attorney, however, was not persuaded of applicant's right to registration and maintained the final refusal. The appeal was resumed and applicant and the examining attorney have filed briefs. Applicant did not request an oral argument.

Applicant has not, in any response to an Office action or in its brief, disputed the descriptiveness of GROUNDING SYSTEM for its collection of items that, sold as a unit, "bleed electrical charges to the earth." In fact, in its brief, applicant states that the disclaimed matter "does not form an important part of the refusal" and "arguments

Office action) have treated the refusal, and briefed this appeal, on the question of whether the phrase as a whole is registrable.

will mainly concentrate on the term at issue, namely, 'AUGERROD'." Brief, p. 2.

The record consists of only the earlier-mentioned excerpts from the NEXIS database, the copy of the patent for applicant's product, and the advertising flyer featuring applicant's product. In regard to the NEXIS evidence, applicant asserts that these show that "auger rod" is a term with a readily understood meaning only in regard to drilling, boring and mining, where an auger rod is used to remove earth, while the AUGERROD component of applicant's product is used to anchor applicant's system to the earth. Applicant also contends that prospective customers for its product would not readily recognize that this anchoring rod of its grounding system bears a resemblance to an auger rod used in drilling or mining, because they would not be familiar with such an item.

The examining attorney argues that applicant may be using an auger rod for a different purpose than drilling, but it is nonetheless clear that an auger rod is a principal component of applicant's grounding system. Specifically, the examining attorney relies on various statements in the patent for applicant's product, such as the following:

An auger rod engages the earth so as to be conductively connected to the earth, and an electrical line serves to connect the auger rod to the tower.² (from Abstract)

In the present invention, the tower is electrically grounded to the earth by using an auger rod. The auger rod engages the earth so as to be conductively connected to the earth. An electrical line is connected to the auger rod and is conductively connected to the tower. In particular, a plurality of auger rods engage the earth so as to be conductively connected to the earth and are arranged in a geometric configuration around the tower. (paragraph 2 of Summary of the invention)

FIG. 4 is a detailed side elevational view of the auger rod used with the present invention. (from Brief Description of the Drawings)

We claim: ... an auger rod engaging the earth so as to be conductively connected to the earth; and an electrical line connected to said auger rod and conductively connected to said tower. ... a plurality of auger rods engaging the earth so as to be conductively connected to the earth, each of said plurality of auger rods forming a geometric configuration around said tower. (from claims 2 and 3 of the Detailed Description of the Invention).

The examining attorney asserts that applicant's use of "auger rod" in the patent is as a descriptive term and indicates that "such terminology is probably the easiest and clearest to use" in identifying the components of the grounding system.

Applicant argues, however, that its use of "auger rod" in the patent "is [as] a term describing the physical item

² In the statement of the Technical Field for the patented product, there is the following: The present invention relates to apparatus for protecting towers and/or structures from lightning strikes. More particularly, the present invention is a preventive device for avoiding lightning strikes.

'auger rod', not its function, which in the present case is to discharge lightning strikes into the earth, not dig holes." Request for Reconsideration, p. 2. Further, applicant argues: "When drafting a patent that includes a trademarked good, it is standard practice to use the trademarked name to describe the good. ... The term "auger rod" was used in the patent to properly describe the trademarked good, not to describe the actual part of the [identified] goods as claimed by the Examiner." Brief, p. 6.

The above-quoted statement from applicant's request for reconsideration suggests that applicant believes the term AUGERROD cannot be found to be descriptive if it merely describes a physical component of applicant's grounding system, as opposed to the function it performs. To the extent applicant did intend to say exactly that, we note that the case law is to the contrary. It is well settled that a term can be held merely descriptive of a product if it describes "a function, or purpose, or use of the goods ... a feature or part of the goods [or] information about any properties of the goods." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978) (footnotes omitted). In this case, to the extent that AUGERROD is determined to describe a part of

applicant's grounding system, that is sufficient basis on which to hold the term descriptive. And that is precisely the basis for the examining attorney's refusal, i.e., he argues that AUGERROD would be viewed by prospective customers for applicant's product as identifying a basic component of the system. Brief, p. 2.

In regard to applicant's assertion that it used the term "auger rod" in the patent as a trademark, the examining attorney notes that there is nothing in the patent document to indicate that the term "should be interpreted as possessing any significance other than its common commercial meaning, as a helical shaped drilling element." Brief, p. 6. Even if we accept as true applicant's contention that it is "standard practice" to utilize trademarks in descriptions of inventions, a point for which applicant provides not support, we agree with the examining attorney that applicant did not use the term as a trademark in its patent. In this regard, we note that applicant also used the term "auger" interchangeably with "auger rod" in the patent. Had applicant intended the use of "auger rod" to stand in contrast to "auger" as a trademark would to a generic term, then applicant would have been expected to utilize capital letters, or quotation

marks or some other means to indicate the claim to "auger rod" as a trademark for a component of its system.

Applicant also argues that the refusal is based on the patent alone and that there is no evidence of use of the term AUGERROD in commerce. Finally, applicant argues that consumers of its product would not immediately perceive the significance of the term and would have to exercise imagination, cogitation or mental processing to understand the significance of the term.

While the examining attorney certainly has relied a great deal on the patent as evidence of descriptiveness, this does not prevent us from determining that AUGERROD is descriptive on the record as a whole. Nor does the fact that applicant may be the only purveyor of tower grounding systems to use the term AUGERROD mean that the term will be perceived as a trademark rather than as a descriptive term. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983).

Applicant asserts that the purchasers of its system "will be commercial establishments, such as radio stations, telephone companies, airports and other facilities which use elevated communication transmission equipment." Response to Office action, p. 2. We believe purchasers for

such companies would be familiar with the term "auger"³ and its various meanings, as well as with the nature of a "helix,"⁴ and would, upon seeing the term AUGERROD used in conjunction with a grounding system that utilizes "multi-helix grounding electrodes," immediately conclude, without need of thought, cogitation or imagination, that AUGERROD refers to "multi-helix grounding electrodes." Moreover, as seen by reference to applicant's advertising flyer, applicant uses "AugerRod" as the name of the auger-shaped or multi-helix grounding electrodes displayed as an element of its system. Notwithstanding that applicant has used a "TM" designation with the term, it has not used a noun, i.e., it has not on its advertising used "AugerRod grounding electrode" or any other such combination. While this usage does not dictate that applicant cannot acquire trademark rights in the term AUGERROD, it does tend to

³ We take judicial notice of the listing of "auger" in the following telecommunications industry dictionaries:

"Auger A device that looks like a giant drill bit, which is used for boring holes into the ground for telephone or power poles. Some utility construction vehicles are equipped with augers." McGraw-Hill Illustrated Telecom Dictionary 54 (2d ed. 2000).

"Auger A type of drill bit typically used to make large, deep holes for passing wire or cable through wood." Newton's Telecom Dictionary 67 (2001).

⁴ We take judicial notice of the following: **"helix also helixes** ...3: a curve traced on a cylinder by the rotation of a point crossing its right sections at a constant oblique angle..." Webster's Third New International Dictionary 1051 (1993).

prompt prospective customers to perceive the term as the name of the component. In any event, we need not rely on the advertising to support our holding that AUGERROD would, for prospective purchasers of applicant's grounding system, be perceived as describing a principal component of the system.

Decision: We affirm the examining attorney's refusal under Section 2(e)(1) to register AUGERROD GROUNDING SYSTEM because it is descriptive of a product identified as "multi-helix grounding electrodes, conductors, busses sold as a unit to bleed electrical charges to the earth."